#28

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS:	Richard D. Cappels, Sr. et al.
SERIAL NO.:	09/160,503
FILING DATE:	September 24, 1998
TITLE:	Apparatus and Method for handling Special Windows in a Display
EXAMINER:	Thomas Joseph
ART UNIT:	2173
ATTY.DKT.NO.:	P2267/1021

CERTIFICATION OF MAILING

I hereby certify that this paper is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231, on the date printed below:

Date: February 27, 2001 David Lewis

David Lewis

COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

Sir:

PETITION OF THE DECISION ON PETITION UNDER 37 CFR §1.181(a)(3)

This is a petition petitioning the Decision on Petition mailed January 25, 2001 (paper #15).

Point to be Reviewed (37 CFR §1.181(b))

The point to be reviewed is whether the denial of the petition to withdraw the finality of the Office Action of paper # 9 was proper. This includes two issues, which are (1) whether the Examiner's Final Office Action was defective, which further includes

(a) whether the Examiner's Final Office Action complied with MPEP §707.07(f),

(b) whether the Examiner's Final Office Action was "complete" in the sense of 37 CFR §1.104(b), and

(c) whether the Examiner's Final Office Action "clearly" stated the reasons in support of the rejection in the sense of 37 CFR §1.113; and

(2) whether the defects in the Examiner's Final Office Action warrant the sending of a second Office Action without these defects replacing the first.

Statement of Facts Involved (37 CFR §1.181(b))

In an Office Action mailed February 7, 2000 (paper #6) claims 5-10, 12, 25-30, 32 and 41-43 were rejected over McLaughlin et al in view of Shafer. There were also other rejections in paper #6, however, they are not relevant to this petition.

In a response June 12, 2000, the Applicants argued the substance of the rejections and the substance of the references relied upon. In the paragraph bridging pages 11 and 12 of this response the substance of the rejection of claims 5-10, 12, 25-30, 32 and 41-43 over McLaughlin et al in view of Shafer and the substance of McLaughlin et al. and Shafer are discussed.

In an Office Action mailed July 27, 2000 (paper #9) the rejection of claims 5-10, 12, 25-30, 32 and 41-43 was repeated essentially verbatim. The Examiner also stated (the last sentence of the first full paragraph of page 15)

> Although the Applicant has made some attempts to traverse the use of secondary references cited by the Examiner, the Applicant fails to provide reasoning which is understandable to one with ordinary skill in the art.

The Examiner gave no further discussion of the arguments of the paragraph bridging pages 11 and 12.

In the Amendment After Final filed October 26, 2000, the Applicants requested that the Examiner withdraw the finality of the rejection, explaining that the Final Office Action was incomplete in that it failed to address the arguments presented by the Applicants regarding the rejection of claims 5-10, 12, 25-30, 32 and 41-43.

The Examiner sent an Advisory Action on November 9, 2000 (paper # 11), which did not address the Applicants request to withdraw the finality of the rejection.

On November 27, 2000 the Applicants filed a petition petitioning the Finality of the rejection and requesting a complete Office Action.

On January 25, 2001 the Group Director mailed a Decision On Petition Under 37 CFR §1.181 to Invoke Supervisory Authority (paper #15) denying the petition.

On February 9, 2001 the Applicants filed an Information Disclosure Statement.

An Appeal Brief and second Amendment After Final are being filed herewith.

Authority for the Principle that not Answering the Substance of the Applicants' Arguments is a Defect in an Office Action Requiring a New Office Action

A broad unsupported statement about the Applicants Arguments not being understandable does not satisfy MPEP 707.07(f)

> MPEP §707.07(f) is entitled "Answer All Material Traversed" and clearly states
>
> Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

Thus MPEP §707.07(f) clearly requires the Examiner to answer the substance of arguments traversing a rejection. Logically, it follows that in situations in which the Examiner finds a traversal unintelligible, an explanation discussing the substance of the traversal and why it is unintelligible should be given.

To further elaborate a broad allegation of the Applicants' arguments being not understandable without any further discussion does not satisfy MPEP 707.07(f) because it is similar to a broad statement that the arguments were considered but are not deemed persuasive because neither entails a discussion of the substance of the Applicants' arguments. Further, whenever two parties have an honest disagreement it can be viewed as each party does not understand or fully understand the other side's position. In theory, the party that is correct does not understand the party that is wrong because they are wrong and the party that is wrong does not understand the party that is correct because of a failure to see the correct point of view in the proper light. Both an unsupported allegation of arguments not being persuasive and an unsupported allegation about the

arguments being unintelligible convey little more information, if any, about how the Applicants can perfect their position beyond giving more explanation. Thus, the broad statement of the Examiner cited above (paper #9, page 15) about not understanding the Applicants' traversal does not satisfy MPEP 707.07(f) because it is tantamount to a broad statement that the arguments are not persuasive in that every honest disagreement can be viewed as misunderstanding at some level, little if any information is given about how the Applicants can perfect their position beyond giving more explanation and, more importantly, because of the lack of a discussion of the substance of the arguments.

Basis for the requirements of MPEP 707.07(f) can be found in 37 CFR 1.113 or 37 CFR 1.104(b)

37 CFR §1.113(b) states

> In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof (emphasis added).

Thus, the final rejection needs to "clearly" state its reasons.

MPEP §707(f) is a subsection of MPEP §707.07, which is entitled, "Completeness and Clarity of Examiner's Action" and begins by citing 37 CFR §1.104(b), which states,

> Completeness of examiner's action. The examiner's action will be complete as to all matters....

MPEP §707.07 is apparently intended to explain what 37 CFR §1.104(b) meant by "The examiner's action will be *complete* as to all matters...," and that 37 CFR §1.104(b) requires completeness and clarity of the action. In addition to clarity being part of the completeness of 37 CFR §1.104(b), 37 CFR §1.113 also makes a requirement of a final

rejection being clear or having clarity which can be equated with the clarity referred to in the title of MPEP §707.07. It logically follows from the fact that MPEP §707.07(f) is a subsection of MPEP §707.07 that "Completeness and Clarity of Examiner's Action" includes answering the substance of all arguments traversing a rejection. Thus, in addition to the explicit requirement of MPEP §707.07(f) to answer the substance of the Applicants arguments, the layout of MPEP §707.07 suggests that MPEP §707.07(f) can be derived from the requirement of 37 CFR §1.113 that the final action be clear and the requirement of 37 CFR §1.104(b) that every action be complete.

An explanation for how MPEP §707.07(f) can be logically derived from the completeness (37 CFR §1.104(b)) or clarity (37 CFR §1.113) requirements is that, even if an Examiner's rejection is proper, as long as there is something that *appears* to be a flaw in the Examiner's reasoning, the Examiner's position is not fully developed and the action is not "complete" (within the meaning of 37 CFR §1.104(b)) or clear (within the meaning of 37 CFR §1.113). An unanswered question creates the appearance of a flaw in the Examiner's reasoning whether or not a proper answer exists. A discussion of the substance of the rejection and the substance of the references relied upon in support of an allegation that the rejection is flawed creates a question regarding the validity of the rejection and the appearance of a flaw in the rejection, even if the rejection is proper. If the Examiner does not answer this question in his next communication, the appearance of a flaw remains, leaving the Examiner's position appearing flawed and therefore not fully developed, clear, or "complete," even if the rejection is ultimately found to be proper.

The need to send a new Office Action when MPEP 707.07(f), 37 CFR 1.113 or 37 CFR 1.104(b) are not satisfied

The lack of response of an Examiner to an argument by an Applicant is analogous to the lack of response by an Applicant to a rejection or requirement. Just as in the latter case the Applicant is required to submit a new response it would follow in the former case the Examiner would be required to send a new Office Action.

Logically an action that is not "complete" or does not comply with MPEP §707.07(f) is defective and therefore should be corrected and resent, restarting the statutory period for response. This in turn requires removing the finality of the original Final Rejection no differently than were the original Final Office Action missing a page, sent to the wrong address, or had the action crossed an amendment in the mail room of the Patent Office (cf. MPEP §714.05 the section entitled, "ACTION CROSSES AMENDMENT" and MPEP §707.13, which cites *Ex parte Gourtoff*, 1924 C.D. 153, 329 O.G. 536 (Comm'r Pat. 1924)).

MPEP §710.06, entitled, "Situations When Reply Period Is Reset or Restarted," states

> Where the citation of a reference is incorrect or an Office action contains some other defect and this error is called to the attention of the Office ...., the Office will restart the previously set period for reply to run from the date the error is corrected,.... If the error is brought to the attention of the Office within the period for reply set in the Office action but more than 1 month after the date of the Office action, the Office will set a new period for reply, ... The new period for reply must be at least 1 month and would run from the date the error is corrected.
>
> Where for any reason it becomes necessary to remail any action (MPEP §707.13), the action should be correspondingly redated, as it is the remailing date that establishes the beginning of the period for reply. Ex parte Gourtoff, 1924 C.D. 153, 329 O.G. 536 (Comm'r Pat. 1924).

> A supplementary action after a rejection explaining the references more explicitly or giving the reasons more fully, even though no further references are cited, establishes a new date from which the statutory period runs (emphasis added).

In other words, MPEP §710.06 establishes that (1) a new Office action needs to be sent in situations where there was a defect (e.g. the lack a discussion of the substance of the Applicants' arguments traversing a rejection) in the original Office action, (2) the period of response should be at least one month if the error was pointed out within the period for reply and (3) the last of the above cited paragraphs implies that in the present case since the Examiner would need to send "A supplementary action after a rejection ... giving the reasons more fully" the supplemental action, "establishes a new date from which the statutory period runs" implying that the full statutory period runs. Since, unlike a missing page or missing reference, the nature of the defect is not one that can be easily spotted by glancing through the Office Action, the full three months shortened statutory period for reply should be granted.

The Applicants' Position

Thus, the Examiner did not discuss the substance of the Applicants' response to the rejection of claims 5-10, 12, 25-30, 32, 41-43 and therefore did not comply with MPEP §707.07(f). Consequently, the Examiner's Final Action is defective and therefore a new Office Action should be written correcting this defect (cf. MPEP §710.06). Logically, writing this new action requires removal of the finality of the previous Final Action and resetting the statutory period for response similar to the situation in which an Office Action was sent with missing pages, to the wrong address, or crossed a response.

Response to Statements of the Group Director in paper #15

The Group Director stated (the last sentence of page 1 of the Decision on Petition, mailed January 25, 2001, paper # 15),

> whether the rejections over art are correct are appealable issues not subject to petition.

However, the Applicants never asked the Group Director to rule on the correctness of the substance of the Examiner's rejection. The Applicants merely asked the Group Director to (1) rule on the correctness of Finality of the final rejection and (2) asked for a response to the arguments first presented in the Applicants' response filed June 12, 2000 in the paragraph bridging pages 11 and 12.

The Board of Appeals and Interferences and the courts do not have the supervisory authority to require the Examiner to answer the Applicants' arguments with a discussion of the substance of their arguments. Therefore, this petition is

> From [an] ... action ... of ...[an] examiner in the *ex parte* prosecution of an application, ...which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court [in compliance with 37 CFR §1.81(a)(1)].

The Group Director further stated (page 2, paper #15)

> A careful reading of the final rejection indicates the Examiner has a fully developed a position on the issues in the action.

The Applicants take issue with the phrase "fully developed." The Examiner has developed a position, but not fully in that he has not responded to the substance of the arguments first presented in the response of June 12, 2000 in the paragraph bridging pages 11 and 12.

The Applicants' response of June 12, 2000 (the paragraph bridging pages 11 and 12) clearly discusses the substance of both references in question and the substance of the

rejection of the Examiner, thereby creating at least the appearance of a flaw in the Examiner's line of reasoning irrespective of whether the Examiner's position was correct. Even were the Examiner's rejection proper, as long as there is something that appears to be a flaw in the Examiner's reasoning the Examiner's position is not fully developed and the action is not "complete" (within the meaning of 37 CFR §1.104(b)) or clear (within the meaning of 37 CFR §1.113). The Examiner's broad unsupported assertion that the Applicants' arguments are not understandable is not a discussion of the substance of their arguments. The Examiner could have explained why he felt the Applicants' arguments were unintelligible and included in his explanation a discussion of the substance of the arguments, but he did not. Consequently, the Examiner's position is not fully developed, clear (37 CFR §1.113), or "complete" (37 CFR §1.104) because the arguments bridging pages 11 and 12 (even if wrong) create at least the appearance of a flaw in the Examiner's reasoning, even were the Examiner's rejection well correct. Further, the Applicants respectfully submit that the Examiner did not comply with the requirement of MPEP §707.07(f) to discuss the substance of all arguments traversing a rejection.

The Group Director continued (in the next sentence)

> the issues have been presented ... in multiple Office communications before and including the final rejection.

The Applicants respectfully submit that this statement inadvertently conveys the wrong impressions as to the number of times the Examiner has stated his position and developed it. The Applicants respectfully submit that although the Group Director states "multiple Office communications" there are only two in which the Examiner stated his position, which are the first Office action, mailed February 7, 2000 (paper #6) and the Final Office Action (paper # 9) which contains essentially a verbatim repetition of the rejection of

paper #6. Thus, the Applicants respectfully submit that a more accurate statement would be that the Examiner developed his position in only one communication (paper #6) and in response to the Applicants' arguments of June 12, 2000 the Examiner repeated his position essentially verbatim without further significant development in a second communication (paper #9) thereby glossing over the Applicants' arguments, in contrast to the requirements of MPEP §707.07(f).

The Applicants respectfully submit that the Group Director never explicitly addressed the requirement of MPEP §707.07(f) to discuss the substance of all arguments traversing a rejection.

Action Requested (37 CFR §1.181(b))

Accordingly the Applicants respectfully request the withdrawal of the Finality of the previous rejection and submit that should the Examiner maintain his rejection a new rejection should be written discussing the substance of the response of June 12, 2000, resetting the period of response.

Summary and Conclusions

A requirement of discussing the substance of the Applicants' arguments as found in MPEP §707.07(f) can be derived from the completeness requirement of 37 CFR §1.104(b) or the clarity requirement of 37 CFR §1.113.

The Examiner could have discussed the substance of the Applicants' arguments in terms of precisely what he felt made them unintelligible, but did not.

Thus, the Examiner's Final Office Action was defective because the broad unsupported allegation that the Applicants' arguments were not understandable is equivalent to, and gave essentially no more indication as to how the Applicants could perfect their position than, had the Examiner made a broad allegation that the Applicants' arguments were not persuasive and, more importantly, it did not discuss the substance of the Applicants' response to the rejection of claims 5-10, 12, 25-30, 32, 41-43 and therefore did not comply with MPEP §707.07(f).

Defects in an Office Action should be corrected (cf. MPEP §710.06, the first two paragraphs).

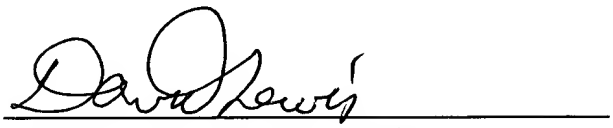
Logically, correcting of noncompliance with MPEP §707.07(f) requires that a supplemental Office Action be written.

Defects requiring the writing of a Supplemental Office Action (such as noncompliance with MPEP §707.07(f)), which in turn requires removal of the finality of the previous Final Action, also require the resetting the statutory period for response under the third full paragraph of MPEP §710.06.

Therefore for the above reasons the granting of this petition is respectfully requested.

Respectfully Submitted,

Richard D. Cappels, Sr.

Date: February 27, 2001 By: 

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